

REMARKS

Applicants would like to express appreciation to the Examiner for the detailed Official Action provided. By the present Amendment, claim 1 will have been amended and claim 32 will have been added. Claims 1, 3-5, 29 and 32 remain pending in the application for consideration by the Examiner. Applicants respectfully request reconsideration of the outstanding rejection and allowance of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate.

The Examiner has rejected claims 1, 3-5 and 29 under 35 U.S.C. § 103(a) as being unpatentable over JPU 7-51066 to SHIMIZU in view of U.S. Patent No. 6,010,478 to BELLHOUSE, finding that SHIMIZU teaches all of the limitations of the above claims except for (with respect to claim 1) the wall surface extending in a forward direction and at an angle different from said wall surface. However, the Examiner has determined that BELLHOUSE teaches a such a limitation, and concludes that it would have been obvious to include this feature into the device of SHIMIZU.

Applicants respectfully traverse the Examiner's rejection, and submits that the applied references are markedly different from the present invention as claimed. Applicants further expressly incorporate herein all arguments proffered in Applicants' previous responses. With respect to independent claim 1, the applied references fail to teach or suggest at least an annular, protruded wall configured to reflect liquid ejected from said spray nozzle. Applicants note that this feature is described in Applicants' specification at, *inter alia*, page 8, lines 2-9. For example, BELLHOUSE is not directed to a spray nozzle or a nozzle that sprays a liquid, but rather is directed to a syringe that accelerates a powderous material across skin or mucosal tissue. Further, BELLHOUSE's "wall

surface extending in a forward direction” identified by the Examiner is a soft, annular spacer 13 that serves as a buffer area between the nozzle portion 7 and target tissue. As such, BELLHOUSE cannot teach or suggest at least a wall that reflects liquid ejected from a spray nozzle.

Moreover, Applicants respectfully submit that the Examiner has not set forth a proper motivation as required by 35 U.S.C. § 103 to combine the teachings of JPU 7-51066 and BELLHOUSE in the manner asserted by the Examiner. It is clear that the Examiner has, based upon Applicants’ own disclosure, picked various individual features of the references and has combined them in the manner taught by Applicants’ disclosure. This hindsight reconstruction is inappropriate under 35 U.S.C. § 103.

Applicant submits that rejection based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). As stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984):

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

For example, as noted *supra*, BELLHOUSE is not directed toward an endoscope, as recited in claim 1, rather it is directed toward a needleless syringe capable of accelerating particles across skin or mucosal tissue. According to BELLHOUSE, the a soft, annular spacer 13 serves as a buffer

area between the nozzle portion 7 and target tissue, which does not teach or suggest an annular, protruded wall extending in a forward direction and at an angle different from said wall surface, the annular, protruded wall being configured to reflect liquid ejected from said spray nozzle.

Further, not only is the present invention and at least the BELLHOUSE reference classified differently (class 606/subclass 46 – surgery/endoscopic, and class 355 – surgery/material expelled from injector by pressurized fluid, respectively), the structure and function of the respective inventions are markedly different, *e.g.*, the present invention being directed toward an endoscope having a liquid spraying nozzle; and the SHIMIZU reference being directed toward a needleless syringe capable of accelerating particles across skin or mucosal tissue. Thus, the present claimed invention and the applied SHIMIZU et al. reference are non-analogous. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973).

With respect to the Examiner's assertion that "a change in size or shape is generally recognized as being within the level of ordinary skill in the art," Applicants respectfully traverse the Examiner's assertion and submit that such assertion is without proper bases, and further direct the Examiner's attention to page 8, lines 10-13, which notes that the structure of the present invention "showed a remarkable advantage." It is thus respectfully submitted that claim 1 and the claims dependent therefrom are patentable over the applied references.

With respect to the Examiner's rejection of dependent claims 3-5 and 29, since these claims (as well as newly-added dependent claim 31) are dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further

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define the present invention over the references of record. It is thus respectfully submitted that all rejected claims are patentably distinct from the references of record.

Thus, Applicants respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. § 103 and respectfully requests the Examiner to indicate the allowance of each and every pending claim in the present application.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that the present amendment is in proper form and that none of the references either taken together or taken alone in any proper combination thereof, anticipates or renders obvious Applicants' invention. Accordingly, consideration of the present amendment, reconsideration of the outstanding Official Action and allowance of the present application and all of the claims therein are respectfully requested and are now believed to be appropriate.

Applicants note that this amendment is being made to advance prosecution of the application to allowance, and no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. The amendments to the claims have not been made for a purpose related to patentability, but rather are clarifying amendments that are cosmetic in nature by rendering explicit what was already implied in these claims (*i.e.*, the annular, protruded wall being configured to reflect liquid ejected from the spray nozzle). The amendments to the claims should thus be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto. Accordingly, this amendment should not be considered a decision by Applicants to narrow the claims in any way.

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Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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